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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

4015-5165

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Application Number

10/747,752

Filed

Dec. 29, 2003

First Named Inventor

Cheng

Art Unit

2617

Examiner

Cai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 55,275

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Daniel P. Homiller

Typed or printed name

919-854-1844

Telephone number

Sep. 3, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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In re Application of
Cheng, et al.

Filed: December 29, 2003

For: Network Controlled Channel Information Reporting

PATENT PENDING

Examiner: Mr. Wayne Huu Cai

Group Art Unit: 2617

Confirmation No.: 6122

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As detailed more fully below, Applicant submits that the pending rejections of independent claims 1, 21, 52, and 58 include at least two clear errors, either of which renders the rejections of all of the pending claims improper. First, in the final office action dated June 4, 2008 (hereinafter “Office Action #6”), the Examiner errs in finding that Müller, *et al.* (WO 00/70897, hereinafter “Müller”) discloses “a mobile terminal receiving at least one common feedback criterion broadcast to a plurality of mobile terminals.” Office Action #6, p. 5. Second, the Examiner errs in combining Müller with Chen *et al.* (US 6,748,224, hereinafter “Chen”), as such a combination would not have been obvious to one of ordinary skill in the art at the time was made, and, in any event, would not yield the claimed invention.

“Common Feedback Criterion Broadcast to a Plurality of Mobile Terminals”

Independent claim 1 is directed to a method that includes “receiving at least one common feedback criterion broadcast to a plurality of mobile terminals.” Independent apparatus claim 21 includes a corresponding limitation, while independent claims 52 and 58 are directed to a base station and a corresponding method for determining common feedback criterion to be broadcast to a plurality of mobile terminals. The remaining dependent claims necessarily include the same limitations.

Previous responses by the Applicant have demonstrated that Müller fails to disclose this claimed feature. For instance, Applicant’s response dated November 6, 2006 (hereinafter “Response #3”) points out that Müller (referred to as “WO” in that paper) clearly teaches an approach in which parameters are sent to mobile stations on a *mobile-by-mobile* basis. Response #3, pp. 14-15. Applicant’s response dated June 11, 2007 (hereinafter “Response #4”) also demonstrated that Müller fails to disclose or suggest the “common feedback criterion” of the pending claims, explaining that the terms “common” and “broadcast” each have clear meanings in their context, and that these terms cannot be ignored. Response #4, pp. 2-3. Finally, Applicant’s response dated September 24, 2007 (hereinafter “Response #5”) explained once more that Müller teaches only the sending of measurement control messages to mobile stations on a mobile-by-mobile basis, and that the reference therefore fails to disclose “common feedback criterion broadcast to a plurality of mobile terminals.” Response #5, pp. 5-6.

In the current office action, the Examiner rejects these arguments, asserting that the term “common feedback criterion” is “broadly and reasonably interpreted as a condition that is transmitted from the base station to the mobile terminal.” Office Action #6, p. 4. Applicant submits that this is a clearly erroneous interpretation of the claimed feature, as it completely fails to account for the term “common” and also ignores that the claims recite that the common feedback criterion is “broadcast to a plurality of mobile terminals,” as required by each of the

independent claims. It is neither “reasonable” nor legally proper to interpret individual words or phrases of a claim in complete isolation from the rest of the claim. In context, the claim term “common feedback criterion broadcast to a plurality of mobile stations” clearly indicates to one of ordinary skill in the art that the feedback criterion are simultaneously transmitted to and applicable to two or more mobile stations. This is not taught by Müller, and is not taught or suggested by Müller in combination with Chern.

“Basic and Enhanced” Channel Reports

In independent claim 1, a mobile terminal normally provides a *basic* channel report that at least partially characterizes a downlink channel. Based on the common feedback criterion discussed above, the mobile terminal selectively provides an *enhanced* channel report that provides a more detailed view of the downlink channel than the basic report. The current office action alleges that Müller discloses a mobile terminal “selectively providing an enhanced channel report ... wherein said enhanced channel report provides a more detailed view of said downlink channel than said basic channel report.” Office Action #6, p. 5.

The Applicant respectfully submits that the Examiner has again improperly ignored the context of the claim itself in interpreting the term “enhanced channel report.” As previously argued by Applicant, Müller fails to distinguish between a basic channel report that is normally provided by a given mobile terminal and an enhanced channel report that is selectively provided by that mobile terminal. Response #5, pp. 2-5. Indeed, Müller teaches away from the current invention, teaching the exclusive use of event-based reporting as an *alternative* to prior art systems that periodically send channel condition reports. Müller thus does not contemplate a terminal that sends a certain type of report by default, i.e., normally, and a different type of report at other times. See Response #5, pp. 3-4. The Examiner’s arguments in the current office action to this point, see Office Action #6, p. 3, are in clear error. Müller simply states that the report that is sent upon the satisfaction of an event or condition “may include more or less

information as established by the radio network operator.” Müller, p. 10, lines 25-26. This teaching falls well short of disclosing or suggesting that an enhanced channel report is selectively substituted for a normally provided basic channel report.

For related reasons, the combination of Müller with Chen is also clearly erroneous. After alleging that Müller teaches the enhanced channel reports of the claimed invention, the current office action acknowledges that Müller “does not specifically teach or suggest a mobile terminal normally providing a basic channel report,” and proffers Chen to supply the missing limitation. Office Action #6, p. 5. The office action continues by asserting that it would have been obvious to combine Müller with Chen, and that the “motivation/suggestion for doing so would have been to accurately monitor and control the communication between the mobile station and network infrastructure.” As explained in Applicant’s Response #5, Chen actually discloses only the providing of a single type of channel report used to support the determination of a mobile terminal’s position, and does *not* suggest a mobile terminal that normally provides basic channel reports. Response #5, pp. 4-5.

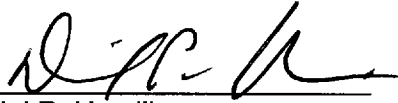
Further, neither reference discloses or suggests a system that selectively switches from the normal providing of basic channel reports to the providing of enhanced channel reports, and Müller in fact teaches away from such a system. The office action’s vague reference to a motivation to “accurately monitor and control ... communication” does not articulate a reasonable rationale for combining the cited references’ teachings, especially in view of Müller’s teaching away from the claimed invention.

Conclusion

Applicant reincorporates by reference its previous arguments presented in Response #3, Response #4, and Response #5, and particularly notes the portions of these responses cited above. In view of these arguments, Applicant respectfully requests reconsideration of the present application and allowance of the pending claims.

Respectfully submitted,

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